



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,808	08/05/2003	Jean Rapin	10945.105004	8829
20786	7590	12/14/2005	EXAMINER	
KING & SPALDING LLP 191 PEACHTREE STREET, N.E. 45TH FLOOR ATLANTA, GA 30303-1763			CORDERO GARCIA, MARCELA M	
			ART UNIT	PAPER NUMBER
			1654	

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/635,808

Applicant(s)

RAPIN ET AL

Examiner

Marcela M. Cordero Garcia

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,6 and 7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,6 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 16, 2005 has been entered.

Claims 1, 3, 6, and 7 are pending in the application.

Any rejection from the previous office action, which is not restated here, is withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, 6 and 7 are presented for examination on the merits.

For the art rejection below, please note that electroconvulsive shock reads upon "traumatic impact", see, e.g., <http://www.answers.com/shock>, definition of "shock", accessed online 12/08/2005. (See also cited definitions for "trauma" and "impact").

### ***Claim Rejections - 35 USC § 103***

Claims 1, 3, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vandai (US 5,212,158) in view of Hock et al. (US 5,043,346).

Vandai beneficially teaches a method for the treatment of amnesia comprising administering an effective amount of a compound of Formula I (e.g., cinnamoyl-glycyl-L-phenylalanyl-L-prolinamide). [See, e.g., abstract, claims, column 16, lines 13-15 and example 9]. Please note that stimulating nerve growth is a functional effect of such administration, which does not distinguish the instant method from the method of Vandai reciting identical steps.

Vandai does not expressly teach the treatment of amnesia due to cerebral infarction or traumatic impact characterized by nerve cell necrosis, but it does teach the treatment of amnesia due to absorption of chemical substances (e.g., scopolamine), and that the compounds used within such treatment (e.g., cinnamoyl-glycyl-L-phenylalanyl-L-prolinamide) have nootropic activity.

Hock et al. beneficially teach that a substance is designated as having nootropic activity when it is able to abolish amnesia produced in the experimental animals by means of an electroconvulsive shock or the amnesia induced by scopolamine (column 9, lines 12-16). Please note that "characterized by cell necrosis" is a functional effect associated to such events.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust particular conventional working conditions within such method of treating amnesia administering an effective amount of a compound of Formula I (e.g., expressly treating amnesia due to electroconvulsive shock instead of treating amnesia due to absorption of, e.g., scopolamine) based upon the overall beneficial teachings provided by Vandai and because it was known in the art (see Hock

et al., column 9, lines 12-16) that nootropic compounds could abolish amnesia produced by electroconvulsive shock (i.e., traumatic impact). These types of adjustments are deemed merely a matter of judicious selection and routine optimization that is well within the purview of the skilled artisan.

Thus, the invention as a whole is prima facie obvious over the reference, especially in the absence of evidence to the contrary.

### ***Conclusion***

No claim is allowed.

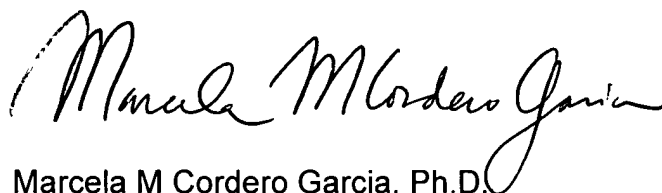
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcela M. Cordero Garcia whose telephone number is (571) 272-2939. The examiner can normally be reached on M-Th 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1654

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Marcela M Cordero Garcia, Ph.D.  
Patent Examiner  
Art Unit 1654

MMCG 12/05



CHRISTOPHER R. TATE  
PRIMARY EXAMINER